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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,609	12/28/2000	Marc Traylor	D-6904	8543

7590 12/03/2001

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EXAMINER

SY, HOLLY N

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/751,609

Applicant(s)

TRAYLOR, MARC

Examiner

Holly Sy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: Certificate of Mailing/Transmission Procedures.

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**Mini Lecture**

***Information to Pro Se Inventors  
Regarding responses to Office Actions***

**INTRODUCTION**

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent. 37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

**DISCUSSION**

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

**I. Response by Applicant**

The applicant **MUST** respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the

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specification, drawings, and/or claims to overcome the rejection or objection.

Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. **The response must be signed by ALL applicants.** 37 C.F.R. § 1.33.

#### *A. Arguments*

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that explain how the claims avoid the references or patentably distinguish from them. *Id.*

#### *B. Amendments to the Specification/Claims*

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be made by replacement of the entire paragraph/section. Additions to the specification should be underlined. Any deletions from the claims should be enclosed in brackets (brackets "[" and "]", not parentheses "(" and ")"). Applicants must provide (a) a clean version of an amended paragraph or section or claim and (b) a marked-up version of the same paragraph or section or claim showing changes. Clear instructions must be provided for the location of the amendment entry (e.g., paragraph number, page/line number). Deletion/Addition of an entire paragraph only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121.

It is not necessary to submit a new specification unless one has been required by the Examiner.

*C. Amendments to the Claims*

An amendment to the claim may remove a rejection or objection. Any amendment to the claim must be made by replacement of the entire claim. Applicants must provide (a) a clean version of an amended paragraph or section or claim and (b) a marked-up version of the same paragraph or section or claim showing changes. Additions to the claim should be underlined. Any deletions from the claims should be enclosed in brackets (brackets "[" and "]", not parentheses "(" and ")"). Deletion/Addition of an entire claim only requires an instruction to delete/add – no marked-up version required for deleted/added items. 37 C.F.R. § 1.121. Parenthetical information is provided after the claim number to indicate how many times the claim has been amended (e.g., "(Once Amended)", "(Twice Amended)", etc ...). 37 C.F.R. § 1.119.

For example, if a claim to a chair was originally written:

I. A chair comprising a horizontal seat, a vertical back, and a plurality of vertical support members.

An amended version of this claim might then be written as follows:

I. (Once Amended) A chair comprising a horizontal seat, a vertical back, and [a plurality of] four vertical [support members] legs attached to said seat.

In this example, the words "a plurality of" and "support members" have been deleted from the claim. The words --four-- and --legs attached to said seat-- have been inserted.

#### *D. Drawing Corrections*

Finally, correction of the drawings may remove a rejection or objection. Changes to the drawings are submitted as proposed drawing corrections and can be made only with permission of the Office. 37 C.F.R. § 1.123. Proposed drawing corrections should be filed with the response, but should be a separate paper. M.P.E.P. § 608.02(r). The proposed corrections should appear in red ink in the drawings. M.P.E.P. § 608.02(v).

#### **II. New Matter**

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

See M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

#### **III. Period For Response**

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37

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C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-326) of the Office action. Usually, a 3 month shortened statutory period is set.

M.P.E.P. § 710.02(b). The applicant's response must be received within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. § 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

<b>Months Past Response Date</b>	<b>Fee Due (Small / Large Entity)</b>
Response within Time Allowed	None / None
1	\$ 55 / \$ 110
2	\$ 200 / \$ 400
3	\$ 460 / \$ 920
4	\$ 720 / \$ 1,440
5	\$ 980 / \$ 1,960

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135.

Three examples are provided:



Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$190 (for a small entity; \$380 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a **2 month** shortened statutory period for response. The response must be accompanied by a fee in the amount of \$680 (for a small entity; \$1,360 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a **3 month** shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

**IV. Certificate of Mailing**

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. See 37 C.F.R. § 1.8. This "Certificate" should consist of the following statement:

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner of Patents and Trademarks, Washington, D.C. 20231"

on (Date of Deposit).

(Name of applicant, assignee, or Registered Representative)

(Signature)

(Date)

This "Certificate" may appear anywhere on the page, and may be handwritten or typed. *Id.* It MUST be signed by the person who actually deposits the paper with the Postal Service, and the date MUST be the actual date on which it is mailed. *Id.*

For the purpose of calculating extensions of time, the date shown on the certificate will be used as the date on which the paper was received by the Office, regardless of the date the Postal Service actually delivers the response. In this way, postal delays would not affect the extension-of-time fee.

Furthermore, Applicant is encourage to include with the response a self addressed and stamped postcard completely itemizing the papers submitted with applicant's response. See M.P.E.P. § 503. When the response is received by the Office, the postcard is date-stamped and returned to the applicant. *Id.* This is an applicant's best indication of the date the Office received the response and if all of the papers submitted have been received.

### **CONCLUSION AND CAVEAT**

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

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Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. See 37 C.F.R. § 1.111; M.P.E.P. § 714.02.

### **DETAILED ACTION**

This is the first office action for application number 09/751,609, Resilient Magnetic Paintbrush Holder, filed on December 28, 2000.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 4. Correction is required. See also objections to the specifications.

#### ***Specification***

The disclosure is objected to because it includes the following reference sign(s) mentioned on page 4, line 22 of the description not shown in the drawings: 4. Correction is required.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: claim 4, line 3, "the improvement" should be replaced with ---an improvement---. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 6 recites the limitation "The improvement" in line 1 respectively.

There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,690,079 to Craig. Craig discloses a holder including a clamp 16, a magnet 98,100, and a resilient member 110 (note Figs. 1-2). Craig also discloses that the resilient member is both a spring and a length of resilient material with a first portion 114 attached to the clamp and second portion 112 attached to the magnet.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 2,498,511 to Smith

U.S. Patent 3,016,169 to Kirshenbaum

U.S. Patent 3,425,012 to Gottinger

U.S. Patent 3,536,285 to Vaughn

U.S. Patent 3,729,158 to Nagy

U.S. Patent 4,101,046 to Puntillo

U.S. Patent 4,991,803 to Buder

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U.S. Patent 5,033,704 to Kerr

U.S. Patent 5,083,733 to Marino et al.

U.S. Patent 6,187,104 B1 to Bozarjian

The above patents disclose various types of paintbrush holders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Sy whose telephone number is (703) 605-1183.

The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3597 for regular communications and (703) 305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Holly Sy  
Patent Examiner  
Technology Center 3600  
Art Unit 3632  
November 14, 2001



ANITA KING  
PRIMARY EXAMINER